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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,201	09/08/2003	Valerie De La Poterie	230172US0	7480
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
VENKAT, JYOTHSNA A				
ART UNIT		PAPER NUMBER		
1619				
NOTIFICATION DATE		DELIVERY MODE		
02/10/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/656,201

Applicant(s)

DE LA POTERIE ET AL.

Examiner

JYOTHSNA A. VENKAT

Art Unit

1619

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-38, 40, 42-44 and 50-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-38, 40, 42-44, and 50-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of amendment and remarks filed on 10/30/08.

Claims 39, 41, 46 and 63-65 have been canceled as per applicants' amendment dated 10/30/08. Claims 36-38, 40, 42-45, 47-62 and 66-68 are pending in the application.

Claims 45 and 47-49 are withdrawn from consideration as being drawn to non-elected species (claim 45 does not have the elected species which is tackifying waxes) and claims 66-68 are withdrawn being drawn non-elected invention.

Claims 36-38, 40, 42-44, and 50-62 are currently examined in the application. Election of species drawn to Tacky wax (single compound) is hereby withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 36-38, 40, 42-44, and 50-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is written description rejection.**

The specification discloses tackifying waxes having a tack of greater than or equal to 0.7 N.s and a hardness from 0.05 MPa to 3.5 MPa drawn to formula (I) such as Kester Wax K 82 P), and Kester Wax 80 P in the instant application at page 9, II 12-27.

However tacky wax also includes the following waxes. These are:

1. Bayberry wax
2. Hydrogenated jojoba wax
3. Candelilla wax
4. Carnauba wax
5. Hydrogenated rice bran wax
6. Japan wax
7. Jojoba butter
8. Jojoba oil
9. Lanolin wax
10. Microcrystalline wax
11. Mink wax
12. Montan acid wax
13. Montan wax
14. Ouricurry wax
15. Ozokerite wax
16. Rice bran wax
17. Shellac wax
18. Synthetic wax an
19. Synthetic Beeswax (no formula)

The specification provides insufficient written description to support the genus encompassed by the claim having tackifying waxes which has tack of greater than or equal to 0.7 N.s and a hardness of from 0.05 MPa to 3.5 MPa.

Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116.)

The skilled artisan cannot envision which waxes are tacky and would possess the property described in claim 1. Adequate written description requires more than a mere statement that it is part of the invention. See *Fiefs v. Revel*, 25 USPQ2d 1601, 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016. In *Fiddes v. Baird*, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence. Finally, *University of California v. Eli Lilly and Co.*, 43 USPQ2d 1398, 1404, 1405 held that: ...To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (" [T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures,

diagrams, formulas, etc., that set forth the claimed invention." Lockwood , 107 F.3d at 1572, 41 USPQ2d at 1966.

Therefore, only the tacky wax having formula I shown to possess the required property described in claim 1 and meet the written description provision of 35 USC § 112, first paragraph. The specification does not teach any other waxes that are tacky actually possessing a tack of greater than or equal to 0.7 N.s and a hardness of from 0.05 MPa to 3.5 MPa, and thus formula I disclosed in the specification is not representative of the genus because the genus is highly variant. Applicant is reminded that Vas-Cath makes clear that the written description provision of 35 USC § 112 is severable from its enablement provision. (See page 1115.)

Claim Rejections - 35 USC § 103

Claims 36-38, 40, 42-44, and 50-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of 5,985,298 ('298) and U.S. Patents 5,783,176 ('176).

Patent '298 teaches cosmetic compositions. See col.5, ll 41-65 for mascara compositions and these compositions have wax. The compositions have volatile solvent and non-volatile oil, film former and emulsifier. The waxes include Kester wax, which is also known as synthetic bees wax. Example 2 has bees wax and synthetic wax instead of synthetic bees wax. The example drawn to mascara has water (solvent). Patent also teaches other cosmetic compositions and this has ethyl alcohol (claims 53-55). Mascara composition has film former, which is polyethylene.. See col. 4, ll 22-24 for the various cosmetic products. Patent also teaches film formers at paragraph bridging col.s 5-6 and teaches that various film formers disclosed in CTFA handbook can be used (claim 93). The difference between the patent and the instant application is patent does not disclose claimed tack value for tacky wax. However, patent '176 teaches tacky

wax claimed in instant application as ester. See the abstract, see col.3, ll 30 through col.4, line 65 and see the paragraph bridging col.s 4-5. Patent at col.5, ll 35-45 teaches surfactants and at col.5, ll 52-61 teaches solvents and at col.8, ll 39-65 teaches conventional cosmetic additives. See the examples. The preferred ester is C₁₉₋₃₉ alkyl hydroxy stearates.

Accordingly, it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of patent '298 and substitute the synthetic beeswax of patent '298 to ester of patent '176 (claimed in instant application as tacky wax and also known as synthetic bees wax since INCI name for Kester wax is synthetic bees wax) . One of ordinary skill in the art would substitute the functional equivalents expecting that the ester of patent '176 (INCI name is synthetic bees wax) can also be used in composition. This is a prima facie case of obviousness.

Restriction between compounds belonging to Tacky wax is withdrawn and therefore the claims are obvious over the following co-pending applications.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 36-38, 40, 42-44 and 50-62 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 and 73-91 and 96 of copending Application No. 10/654,887. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is overlap of subject matter with respect to compositions claimed in the co-pending application and the instant application. Both the instant application and co-pending application use tacky wax, film forming polymer and other additives. There is overlap of subject matter in the instant and co-pending application. Although 10/654, 887 include an additional requirement, i.e., additional waxes, emulsifiers, the use of the claim language "comprising" in instant application permits these additional requirements. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."). *Invitrogen Corp. v. BiocrestMfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495,501,42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the

claim.). Using the transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448,450 (Bd. App. 1948). This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 36-38, 40, 42-44 and 50-62 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 and 79-96 and 102-107 of copending Application No. 10/654,907. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is overlap of subject matter with respect to compositions claimed in the co-pending application and the instant application. Both the instant application and co-pending application use tacky wax, film forming polymer and other additives. There is overlap of subject matter in the instant and co-pending application. Although 10/654, 907 include an additional requirement, i.e., additional waxes, emulsifiers, the use of the claim language "comprising" in instant application permits these additional requirements. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."). *Invitrogen Corp. v. BiocrestMfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495,501,42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are

essential, but other elements may be added and still form a construct within the scope of the claim.). Using the transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. In re Gray, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); Ex parte Davis, 80 USPQ 448,450 (Bd. App. 1948). This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30: 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.